

**Remarks**

Favorable reconsideration of this application, in view of the above amendments and in light of the following remarks and discussion, is respectfully requested.

Applicants respectfully request entry of this response, as the response places the application in clear condition for allowance or alternatively at least places the claims in better form for appeal. Specifically, Applicants have canceled rejected claims without prejudice or disclaimer, and have amended claims to overcome the outstanding rejection.

Upon entry of this response, Claims 3-6 remain pending; Claims 1, 2, and 7 having been presently canceled without prejudice or disclaimer, and independent Claims 3-6 having been presently amended.

In the outstanding Office Action, Claims 1-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,876,266 to Miller et al. (Miller) combined with U.S. Patent No. 6,074,570 to Samonides and U.S. Patent No. 2,800,457 to Green et al. (Green). Applicants respectfully assert that the above amendments to the claims have overcome the outstanding rejection for the following reason.

Applicants respectfully assert that support for the changes to remaining independent Claims 3-6 is self-evident from the originally filed disclosure, including the original claims, and that therefore no new matter has been added.<sup>1</sup>

The present invention is directed to working processes. Independent Claims 3-6 each recite that the working process performs a working of a workpiece with a working fluid, the working fluid containing a solvent and microcapsules filled with liquid-state substances, the microcapsules being dispersed in the solvent. The working process includes recirculating the working fluid through a working machine to reuse the working fluid for subsequent working of the workpiece.

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<sup>1</sup> Please see, for example, page 15, lines 2-6, of Applicants' originally filed specification.

Miller is directed to a polishing pad with controlled release of desired micro-encapsulated polishing agents. As shown in Figure 1, for example, of Miller, a polishing slurry is deposited onto a surface of a polishing pad 63.<sup>2</sup>

Applicants respectfully assert, however, that Miller does not teach or suggest the claimed features of recirculating a working fluid through a working machine to reuse the working fluid for subsequent working of a workpiece, as recited in independent Claims 3-6. Specifically, Applicants respectfully assert that Miller does not show or state recirculating the polishing slurry to reuse the polishing slurry with the polishing pad 63, for example.

Independent Claims 3-6 recite “recirculating the working fluid through a working machine to reuse the working fluid for subsequent working of the workpiece.”

Thus, Applicants respectfully assert that the claimed working processes recited in independent Claims 3-6 provide numerous advantages that are not provided by the polishing pad of Miller. By way of specific non-limiting example, Applicants respectfully assert that the claimed working processes can effectively provide good cooling and lubrication effects on the workpiece even when a small amount of the working fluid is provided to the working point, while eliminating deterioration of an emulsion state due to circulation of the working fluid and still providing economic and environmental benefits related to recirculation and reuse of the working fluid.<sup>3</sup>

The Office Action relies on Samonides and Green in an attempt to remedy the deficiencies of Miller. However, Applicants respectfully assert that neither Samonides nor Green remedies these deficiencies. Rather, Applicants respectfully assert that neither Samonides nor Green teaches or suggests recirculating a working fluid through a working machine to reuse the working fluid for subsequent working of a workpiece.

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<sup>2</sup> Column 3, lines 44-50, of Miller.

<sup>3</sup> Please see, for example, page 9, lines 7-17; from page 15, line 20 to page 16, line 10; and page 23, lines 7-19, of Applicants' originally filed specification.

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Thus, for the above reasons, Applicants respectfully assert that none of Miller, Samonides, and Green teaches or suggests the claimed features recited in independent Claims 3-6. Therefore, Applicants respectfully request that the rejection of independent Claims 3-6 under 35 U.S.C. § 103(a) be withdrawn and the independent claims allowed.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 3-6 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below listed telephone number.

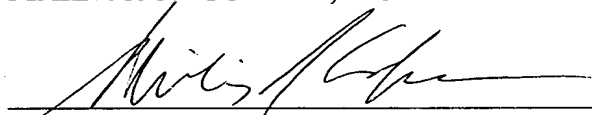
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Respectfully submitted,

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